

Appln. No. 10/626,472
Amendment dated May 30, 2006
Reply to Office Action mailed January 30, 2006

REMARKS

The Examiner has rejected Claim 14 under 35 U.S.C. 112 as failing to comply with the enablement requirement. More particularly, the Examiner indicates that Claim 14 fails to have proper support in the present specification because it does not provide any teaching directed to a bioactive molecule that is reversibly bonded. Both bioactive molecules and reversible bonding are discussed in detail in U.S. patent application Serial No. 10/624,993, published as U.S. Publication No. 2004/0137039, entitled "METHOD FOR CONTROLLED RELEASE OF MOLECULES FROM LAYERED POLYMER FILMS," which application was incorporated by reference in the present specification. For the sake of clarity, applicants' attorney has amended the present specification to add a definition of a bioactive agent taken from U.S. patent application Serial No. 10/624,993. The original paragraph [0048] included an example of reversible bonding. A statement has been added to paragraph [0048] to clarify this example. Applicants' attorney notes that because support for these amendments can be found in U.S. patent application Serial No. 10/624,993, the amendments to the specification do not constitute new matter.

Claims 1, 3, 4, and 13 have been rejected under 35 U.S.C. 112 as being indefinite. With the entry of this Amendment, Claims 1, 3, 4, and 13 have been amended to comply with the requirements of 35 U.S.C. 112. Applicants' attorney notes that because support for these amendments can be found in at least Example 6 and the originally filed drawings (e.g., FIGS. 16 and 31), the amendments to the claims do not constitute new

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matter.

Claims 1, 4-6, 7-10, 12, and 16 have been rejected under 35 U.S.C. 103(a) based upon U.S. Patent No. 6,828,096 to Boussie et al. ("the Boussie Patent"), while Claims 10-13 and 15 have been rejected under 35 U.S.C. 103(a) based upon the Boussie Patent in view of U.S. Patent No. 5,952,232 to Rothman ("the Rothman Patent"). These claim rejections are respectfully traversed for the following reasons.

Amended independent Claim 1 relates to a patterned polymer microgel supported by a substrate, comprising a polymer film including a pattern distributed on a surface of the substrate and having **at least one finely-structured portion spatially resolved at lengths of less than one micron** and a non-patterned portion outside of the pattern. As recited in amended Claim 1, the pattern is distinguished from the non-patterned portion by a distinguishing property.

It is respectfully submitted that the Boussie Patent does not anticipate or make obvious the present invention as recited in amended Claim 1. The Boussie Patent discloses an apparatus to secure multiple polymer samples for characterization. More particularly, the Boussie Patent teaches that polymer samples can be confined within defined regions of a surface by adjusting the hydrophobic or hydrophilic properties of the regions and/or their surrounding areas. The Boussie Patent also teaches that such samples can be confined within dimples formed in the surface.

As conceded by the Examiner, the Boussie Patent does not disclose any regions defined on a substrate that includes finely-structured portions in a submicron

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range. The only discussion of the extent of each region, found at Col. 5, lines 38-47 and Col. 9, lines 35-38 of the Boussie Patent, indicates linear dimensions no smaller than 0.5 mm (500 microns), which are on the order of a thousand times larger than the submicron scale of the patterns in the present invention. There is no indication in the Boussie Patent that one skilled in the relevant art would be motivated to create patterns on the submicron scale, or that the techniques described therein could successfully be applied to create patterns on the submicron scale. Since the microgel recited in amended Claim 1 is not obvious over the Boussie Patent, applicants' attorney respectfully requests the Examiner to withdraw her rejection of amended Claim 1.

The Rothman Patent was only cited against dependent Claims 10-13 and 15, and is not believed to be relevant to the patentability of the microgel recited in amended Claim 1. For instance, the Rothman reference relates to an intracellular delivery system. Applicants' attorney respectfully submits that the Rothman Patent, whether considered individually or in combination with the Boussie Patent, does not anticipate or make obvious the present invention as recited in amended independent Claim 1.

In view of the distinctions discussed above, it is respectfully submitted that the microgel recited in amended independent Claim 1 is patentably distinguishable from the Boussie Patent, regardless of whether it is considered alone or in combination with the Rothman Patent. In such circumstances, it is believed that amended Claim 1 is in condition for allowance. Because Claims 2-16 and new Claim 36 depend from amended Claim 1, they are also believed to be in condition for allowance.

For the sake of good order, applicants' attorney notes that the submittal of this Amendment should not be construed as an admission that the Boussie Patent

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constitutes statutory prior art with respect to the present invention. More particularly, applicants' attorney notes that the Boussie Patent did not issue before the filing date of the present application and, as a result, it does not constitute statutory prior art under 35 U.S.C. 102(b).

In view of the foregoing amendments and remarks, applicants' attorney respectfully requests reexamination and allowance of pending Claims 1-16, and examination and allowance of new Claim 36. If such action cannot be taken, the Examiner is cordially invited to place a telephone call to applicants' attorney in order that any outstanding issue may be resolved without the issuance of a further Office Action.

Enclosed is a Petition for a one-month extension of time to and including May 30, 2006, for which a \$120 fee is due. The Petition authorizes the Examiner to charge this \$120 fee to Deposit Account No. 503571. If there are any additional fees, including extension and petition fees, required as a result of this Amendment, the Examiner is hereby authorized to charge them to Deposit Account No. 503571.

Respectfully submitted,

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